REMARKS/ARGUMENTS

The rejections presented in the Office Action dated March 26, 2007 (hereinafter Office Action) have been considered. Claims 1-29 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

OBJECTIONS FOR INFORMALITIES

The Examiner has objected to Claims 9, 11-12 and 24-25 for informalities. The Applicant respectfully traverses the rejections. Regarding Claims 9 and 11-12, the term "a reproduction" is objected to because, according to the Office Action, "a reproduction" has been defined in Claim 7 from which these claims depend. Regarding Claims 24-25, the term "a variant portion" is objected to for similar reasons because of wording used in Claim 23. Applicants respectfully submit that the claim language is clear on its face. For example, Applicant notes that Claims 7 recites "a reproduction of the Web service message," whereas Claim 9 recites "a reproduction of the invariant portion of the Web service message" and Claim 11 recites "a reference to a data store." Similarly, Claim 23 recites "a variant portion of a Web service message" whereas Claim 24 recites "a variant portion of a Web service response message."

Applicant respectfully submits that the terms "reproduction of" and "variant portion of" are prepositional phrases, and when combined with the objects of the prepositions are clearly defined. Thus Applicant respectfully submits that Claims 9, 11-12 and 24-25 are clear and definite, and withdrawal of the objection is respectfully solicited. In the alternate, the Applicant respectfully submits that the objections are as to form and not necessary to further consideration of the claims. Thus if the objections are not withdrawn, Applicants request that the objections be held in abeyance until allowable subject matter is indicated as provided for under 37 CFR 1.111(b).

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REJECTIONS BASED ON 35 U.S.C. § 101

Rejections Based on Lack of Utility

Claims 1-29 are rejected based on 35 U.S.C. §101 because the claimed invention lacks patentable utility. According to the Office Action, "[i]n accordance with Applicant's specification (page 18, paragraph 0071, Instructions can exist permanently or temporarily in any transmitting medium." (Office Action, p. 3, ¶ 1). Thus the Examiner concludes the "subject matter is not limited to that which falls within a statutory category of invention." Applicants respectfully traverse the rejection. According to the guidelines in MPEP § 2107 II, when reviewing patent application for compliance with the utility requirements of 35 U.S.C. § 101, office personnel are to:

> (A) Read the claims and the supporting written description.
>   (1) Determine what the applicant has claimed, noting any specific embodiments of the invention.
>   (2) Ensure that the claims define statutory subject matter (i.e., a process, machine, manufacture, composition of matter, or improvement thereof).
>   (3) <u>If at any time during the examination, it becomes readily apparent that the claimed invention has a well-established utility, do not impose a rejection based on lack of utility.</u> An invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and (ii) the utility is specific, substantial, and credible. (MPEP § 2107 II)(emphasis added)

Applicant first submits that the claims define statutory subject matter. As stated in the Office Action, "Claims 1-29 are drawn towards a method, system, or article of manufacture comprising: forming and transmitting a reduced message," (Office Action, p. 3, ¶ 1) and methods, systems and articles of manufacture are all statutory categories of invention. Applicants also note that the Examiner has not provided any evidence that the subjects of Claims 1-29 do not have a well-established utility. While not acquiescing to the Examiner's characterization that the claims are directed only to "forming and transmitting a reduced message," Applicant nevertheless submits that "forming and transmitting a reduced

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message" has well-established utility in the field of telecommunications, and thus there is no basis under MPEP § 2107 to impose a rejection based on lack of utility.

Applicant further contests the characterizations made regarding page 18, paragraph 0071, such as that the claimed subject matter "includes a form of energy" because the specification states that "[t]ransmitting mediums include, but are not limited to, transmissions via wireless/radio wave communication networks." First, the Examiner has not provided reference to any claim language to support the contention that the claimed subject matter "includes a form of energy." As recognized in the Office Action, "Claims 1-29 are drawn towards a method, system, or article of manufacture" and thus are presumptively directed to statutory subject matter.

Secondly, Applicants contest the presumption that claimed inventions including or directed to "forms of energy" are per se non-statutory.

> While abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole to determine whether it is for a particular application of an abstract idea, natural phenomenon, or law of nature, and not for the abstract idea, natural phenomenon, or law of nature itself. (MPEP § 2106 IV C)(emphasis added).

Thus a mere assertion that claimed subject matter "includes a form of energy" is insufficient to show the subject matter is non-statutory. The Examiner must show that the claimed subject matter is not directed to **a particular application** of a form of energy, but is directed to **a form of energy itself**, and one that is a natural phenomena or does not produce a useful, concrete and tangible result.

Applicants submit that Claims 1-29 are directed to statutory subject matter and have practical utility. Withdrawal of the 35 U.S.C. § 101 rejections based on lack of utility is therefore respectfully solicited.

Double Patenting Rejections

Claims 1-4 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of Claims 1-2 and 4 of copending application no. 10/819,711. Claim 17 is provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claim

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36 of copending application no. 10/819,711. Claim 21 is provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claim 21 of copending application no. 10/819,711. The Applicant has duly noted the Examiner's provisional rejection, and cannot appropriately address the merits of such a rejection until the claims have been allowed in one or both cases. Thus, upon notification of allowance of the claims of this application, the Applicant will appropriately address the provisional obviousness-type double patenting rejection.

REJECTIONS BASED ON 35 U.S.C. § 102

Claims 1, 7, 11-13, 15-17, 19-21 and 27-28 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Publication No. 2002/0040369 by Multer et al. (hereinafter "*Multer*"). Applicants respectfully traverse the rejections. To anticipate a claim the reference must teach every element of the claim, and it is respectfully submitted that *Multer* does not meet this standard.

Regarding independent Claims 1, 13, 17, 21, 23, and 27, *Multer* fails at least to expressly or inherently describe forming a reduced message based on at least a variant portion of a Web service message, the Web service message including a data set targeted for processing on a network entity, and sending the reduced message targeted for the network entity. *Multer* describes the synchronization of databases using difference data, and does not expressly or inherently describe the use of reduced messages. For example, *Multer* describes "programs specifically designed to transmit and/or receive differencing data from one device to another device, irrespective of the type of file system, data, content, or system hardware configuration" (*Multer* ¶ 0040). The differencing data includes only the changes to one system's data and the instructions for implementing those changes on another system. (*Multer* ¶ 0046). However, nowhere does *Multer* expressly show a reduced message that is formed on at least a variant portion of a Web service message, where the Web service message includes a data set targeted for processing on a second network entity.

Multer is not related to the formation of <u>reduced messages</u> at all, but is instead related to forming data that communicates changes of one system to a second system so that

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a second system can "ensure that both systems contain the same data." (*Multer* ¶ 0048). *Multer's* system is not used to form reduced messages based on other messages, but is used to synchronize data between systems. Thus *Multer* fails to expressly or inherently describe forming a reduced message based on another message.

Multer is also deficient in expressly or inherently describing forming a reduced message based on at least a variant portion of a Web service message. The synchronization data described in *Multer* is not based on a variant portion of a Web service message, but is based on changes to data stored on a system. For example, "[d]ifference information .DELTA. comprises only the changes to System B's data which have occurred on System B." (*Multer* ¶ 0048). As such, *Multer* is describing forming difference data based on changes to a system's data, and is at least deficient in expressly or inherently describing forming a reduced message based on at least a variant portion of a Web service message. Therefore, at least independent Claims 1, 13, 17, 21, 23, and 27 are allowable over *Multer*.

Claims 1-2, 7, 13-14, 17-18, 21-27 and 29 are rejected based on 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2004/0064484 by Polan et al. (hereinafter "*Polan*"). Applicants respectfully traverse the rejections. Applicants respectfully submitted that *Polan* does expressly or inherently teach every element of the rejected claims.

Regarding independent Claims 1, 13, 17, 21, 23, and 27, *Polan* fails at least to expressly or inherently describe forming a reduced message based on at least a variant portion of a Web service message, the Web service message including a data set targeted for processing on a network entity, and sending the reduced message targeted for the network entity. As with *Multer*, *Polan* is directed to synchronizing data repositories such as by using SOAP over HTTP. (*Polan*, Abstract). Synchronization data included in the SOAP messages *Polan* is not a variant portion of the Web service message, but is a change detected in one of the repositories. For example, a "change detection module 40 detects changes in the first data repository 14" and a "client communications module 44 translates the change to a selected transport protocol and transmits the change to a corresponding server communications module" using SOAP over HTTP. (*Polan* ¶ 0021). Therefore, *Polan* describes forming a standard SOAP message based on changes to a data repository,

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and is silent on forming a reduced message based on a Web service message. *Polan* is silent on forming or using reduced messages for any purposes, and therefore, at least independent Claims 1, 13, 17, 21, 23, and 27 are allowable over *Polan*.

Dependent Claims 2, 7, and 11-12 depend from independent Claim 1; dependent Claims 14-16 depend from independent Claim 13; dependent Claims 18-20 depend from independent Claim 17; dependent Claim 22 depends from independent Claim 21; dependent Claims 24-26 depend from independent Claim 23; and dependent Claims 28 and 29 depend from independent Claim 27. These dependent claims also stand rejected under 35 U.S.C. §102 as being anticipated by one or both of *Multer* and *Polan*. While Applicant does not acquiesce with the particular rejections to these dependent claims, including any assertions concerning inherency or the taking of Official Notice, these rejections are now moot in view of the remarks made in connection with independent Claims 1, 13, 17, 21, 23, and 27. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from *Multer* and/or *Polan*. Therefore, dependent Claims 2, 7, and 11-12, 14-16, 18-20, 22, 24-26, 28, and 29 are also in condition for allowance.

REJECTIONS BASED ON 35 U.S.C. § 103

Claims 3-6, 8 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Multer* in view of U.S. Patent No. 6,772,413 to Kuznetsov (hereinafter "*Kuznetsov*"). Claims 8-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Multer* in view of U.S. Patent No. 6,606,525 to Muthuswamy et al. (hereinafter "*Muthuswamy*"). To establish a *prima facie* case of obviousness based on a combination of references, combination of references must at least teach or suggest all of the claim limitations. It is respectfully submitted that the combination of *Multer* and *Kuznetsov* fails to teach or suggest all of the limitations of Claims 3, 4-6, 8 and 10, and the combination of *Multer* and *Muthuswamy* fails to teach or suggest all of the limitations of Claims 8-9.

For the rejections of Claims 3, 4-6, and 8-10, the Examiner relies on *Multer* as teaching the substance of the claims from which these Claims are dependent, namely,

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independent Claim 1. The Examiner does not rely on *Kuznetsov* or *Muthuswamy* as providing a remedy to the deficiencies of *Multer* as it pertains to independent Claim 1, nor do *Kuznetsov* or *Muthuswamy* provide such a remedy. Thus, because neither *Multer* nor *Kuznetsov*, nor *Muthuswamy* teach at least the recitations of Claim 1, combinations of *Multer* with *Kuznetsov* and *Multer* with *Muthuswamy* fails to teach these recitations. Further, combinations of *Multer* with *Kuznetsov* and *Multer* with *Muthuswamy* fail to suggest the invention set forth in Claim 1, as there is no reference to at least forming a reduced message based on at least a variant portion of a Web service message. Nor does such a combination teach or suggest sending the reduced message targeted for the network entity. While other requisites of establishing *prima facie* obviousness may also be absent, the Applicants respectfully submit that the cited combination of references at least fails to teach or suggest all of the claim limitations. For at least this reason, Claims 3, 4-6, 8 and 10 are not rendered obvious by the combination of *Multer* and *Kuznetsov*, and Claims 8-9 are not rendered obvious by the combination of *Multer* and *Muthuswamy*, and withdrawal of the rejection is respectfully solicited.
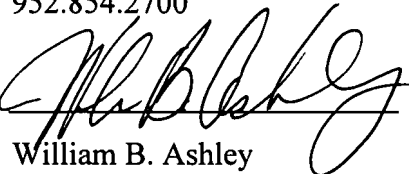
Authorization is given to charge Deposit Account No. 50-3581 (NOKM.059PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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Date: August 20, 2007

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